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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

In re Application of: Robert T. Bell, et al.
Serial No.: 09/032,083
Filing Date: February 27, 1998
Confirmation No. 9496
Group Art Unit: 2665
Examiner: Steven H. D. Nguyen
Title: SYSTEM AND METHOD FOR PERFORMING SIGNALING
ON BEHALF OF A STATELESS CLIENT

Mail Stop Appeal Brief - Patents
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Reply Brief

Appellants have appealed to this Board from the decision of the Examiner, contained in a final Office Action mailed May 17, 2005 (the "Final Office Action"), finally rejecting Claims 1-12, 14-32 and 34-105. Appellants mailed a Notice of Appeal on September 16, 2005 and filed an Appeal Brief on November 16, 2005. The Examiner responded in an Examiner's Answer mailed February 8, 2006 (the "Examiner's Answer"). Appellants respectfully submit this Reply Brief.

Arguments

Status of Claims

Although the Examiner contends that the Status of Claims presented in the Appeal Brief is incorrect, Appellants' Status of Claims and the Examiner's Answer are in precise agreement with respect to the claims pending on appeal. As is stated in both Appellant's Status of Claims and the Examiner's Answer, this appeal involves Claims 1-10, 12, 14-30, 32, and 34-105.

Status of Amendments After Final

Although the Examiner contends that the Status of Amendments After Final presented in the Appeal Brief is incorrect, Appellants and the Examiner again are in agreement. As stated in the Status of Claims section immediately preceding the Status of Amendments After Final section, Appellants canceled selected claims in the Response to the Final Office Action. However, as stated in the Status of Amendments After Final section, Appellants made no amendments to Claims 1-10, 12, 14-30, 32, and 34-105, the claims pending on appeal.

Withdrawn Rejection

Appellant notes with appreciation the Examiner's consideration and withdrawal of the rejection of the claims under 35 U.S.C. § 103. This resolves the ground of rejection addressed in in Section II of the Appeal Brief, leaving only the ground of rejection in Section I (the rejection under 35 U.S.C. § 102) for the consideration of the Board.

Claim Rejections under 35 U.S.C. § 102 (Section I of the Appeal Brief)

Despite the Examiner's continued reliance on *Amir*, this reference fails to describe, either expressly or inherently, each and every element of the claims. As a particular example, *Amir* fails to describe, either expressly or inherently, packet-based stateless clients as required by every claim. Throughout prosecution of this Application, Appellants have labored to understand what elements in *Amir* that the Examiner believes constitute packet-based stateless clients. The Examiner's Answer continues a pattern of identifying different elements at each turn, as it provides yet another list of elements from *Amir* that the Examiner apparently considers to be packet-based stateless clients. Regardless, none of the elements

ever identified by the Examiner describe, either expressly or inherently, packet-based stateless clients as required by every claim.

The Initial Office Action

In the initial office action relying on *Amir*, the Examiner presented a list of elements from *Amir* for packet-based stateless clients and another list for packet-based state-based terminals. The Examiner's lists, however, include obviously inapposite elements and appear to overlap. These two lists are as follows: for packet-based stateless clients, the Examiner identifies "Fig 2A, Ref 42A, 4A, Fig 6, Ref 26, ISDN and analog telephone and IP terminal and Fig 7, Ref 122A, IP telephone," and for packet-based state-based terminals, the Examiner identifies "Fig 2, Ref 48, Fig 6, Ref 26 and Fig 7, Ref 122B, H.323 terminal." *Examiner's Answer*, page 3.¹

As is evident from only a quick review of the first list, the Examiner's identification of packet-based stateless clients includes elements that unambiguously cannot be packet-based. Specifically, the Examiner's list includes analog telephones, which cannot exchange packets as required by the claims. Also, while the Examiner's two lists address mutually exclusive elements, both lists identify "Fig 6, Ref 26." While the first of the Examiner's two lists appears to identify specific ones of "Ref 26," the second list does not.

Given the confusion introduced by these lists, Appellants sought clarification, asserting in a response that *Amir* fails to show packet-based stateless clients.

The Examiner's Response in the Final Office Action

In the Final Office Action, the Examiner responded to Appellants' analysis in a "Response to Arguments" section. In this response, the Examiner identified only two elements as packet-based stateless clients: "Fig 6A, Ref 26s, IP terminal" and "Fig 7, Ref 122A, IP telephone," leading Appellants to believe that the Examiner had refined and clarified his thoughts with respect to what could possibly constitute a packet-based stateless client. *Final Office Action*, pages 7-8. Although the Final Office Action does include the two original lists at page 2, Appellants believed that this was merely an artifact of reproducing the Examiner's entire previously presented argument. Thus in the Appeal Brief,

¹ The Examiner restates these lists word for word in the Final Office Action, at page 2, and again in the Examiner's Answer, at page 3.

Appellants address only the IP terminal and the IP telephone from *Amir*, explaining in detail why these two elements are not stateless clients.

The Examiner's Answer

In the Examiner's Answer, the Examiner presents another "Response to Argument" section, which again revises the list of elements that the Examiner proposes as packet-based stateless clients, listing "Fig 2, Ref 42A, ISDN Telephone, Ref 44A, analog telephone, Fig 6, Ref 26 such as ISDN telephone or analog telephone or IP terminal." *Examiner's Answer*, page 7. With this, the Examiner expands his list of proposed packet-based stateless clients to be virtually co-extensive with his original list, omitting only "Fig 7, Ref 122A, IP telephone" from the final listing.

None of these elements are packet-based stateless clients as required by the claims.

Analog telephones are not packet-based stateless clients as required by the claims

Analog telephones are not packet-based. Analog telephones simply cannot participate in a media stream communication session "comprised of packets exchanged between said stateless client and said state-based terminal." *See Claim 1.*

Amir's IP terminals and IP telephones are not packet-based stateless clients as required by the claims

Sections I.A and I.B of the Appeal Brief address in detail the IP terminals and IP telephones of *Amir*. As Appellants show, the IP terminals and IP telephones of *Amir* are treated as equivalent to the H.323 terminals, which the Examiner admits are state-based. As the Examiner should concede, the IP terminals and IP telephones are state-based terminals, not packet-based stateless clients.

Amir's ISDN telephones are not packet-based stateless clients as required by the claims

Amir addresses the operation of ISDN telephones in only one paragraph of its disclosure. In this paragraph, *Amir* makes clear that ISDN telephones are not packet-based stateless clients. In particular, with respect to ISDN telephones 42, *Amir* states:

The call procedures for voice and video connections are similar in most respects to those discussed above. For example, when telephone A

42A (or video device A 46A) initiates a call to telephone B 42B (or video device B 468), a protocol converter 94 converts the voice signals (video signals) received over line 96 (line 08) to H.323 packets or another protocol, e.g., H.324 or a proprietary protocol.

Amir, col. 9, lines 46-52. Restating this portion of *Amir* slightly to clarify: when ISDN telephone A initiates a call to ISDN telephone B, a protocol converter converts the voice signals received over the line from ISDN telephone A into packets. Thus as specifically described by *Amir*, the ISDN telephone communicates “voice signals” that must be converted into packets. The ISDN telephone of *Amir* thus does not teach a packet-based stateless client participating in a media stream communication session “comprised of packets exchanged between said stateless client and said state-based terminal.” *See Claim 1.*

Amir fails to disclose packet-based stateless clients as required by the claims

As discussed above, none of the elements relied on by the Examiner teach a packet-based stateless client as required by Appellants’ claims. Nor do any other elements of *Amir* disclose these claim requirements. Nowhere does *Amir* disclose, either expressly or inherently, a packet-based stateless client communicating with a packet-based state-based terminal. Therefore, *Amir* does not describe “facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal,” as required by Claim 1, or similar elements present in each and every independent claim.

Conclusion

Appellants have demonstrated that the present invention, as claimed, is patentable over the single reference cited by the Examiner. Therefore, Appellants respectfully request the Board to reverse the final rejection and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

Although Appellants believe no fees are due, the Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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